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EXAMINER

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ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/658,143
Filing Date: September 09, 2003
Appellant(s): LEW ET AL.

MAILED

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GROUP 3600

Dana Andrew Alden
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 19 January 2006 appealing from the Office action mailed 25 January 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief should also include the statement, "there is no amendment after final".

It is noted that Appellant's brief presents arguments relating to the Supplemental Amendment filed on 08 November 2004, which has been denied entry. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. The reason for not entering the Supplemental Amendment is explained below, which is not related to the grounds of rejection to be review on appeal:

The supplemental reply filed on 08 November 2004 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR

1.111(a)(2)(ii). The supplemental reply is not limited to the following:

- a. Cancellation of claim(s);
- b. Adoption of the examiner suggestion(s);
- c. Placement of the application in condition for allowance;
- d. Reply to an Office requirement made after the first reply was filed;
- e. Correction of informalities (e.g., typographical errors); or
- f. Simplification of issues for appeal.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is inaccurate. The changes are as follows:

Whether replacing the originally disclosed "ball bearings" with the "curved members", throughout the entirety of the original specification, introduces new matter into the Application in violation of 35 U.S.C. 132?

Whether the “curved member” recited in claim 19 was sufficiently described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention?

Whether claim 19 is anticipated by U. S. Patent No. 3,432,016 to Vogt, under 35 U.S.C. 102 (b)?

Note:

- The Examiner withdraws the rejection of claim 19 under 35 U.S.C. 112, Second Paragraph. Accordingly, this ground of rejection should be excluded from this Appeal.
- Although a rejection of claims is reviewable by the Board of Patent Appeals and Interferences, whereas an objection and requirement to delete new matter is normally subject to supervisory review by petition under 37 C.F.R. 1.181, if both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition. M.P.E.P. 2163.06 II.
- Appellant’s brief presents arguments relating to claims 20-39, which are part of the 08 November 2004 Supplemental Amendment that has been denied entry. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

A substantially correct copy of appealed claim 19 appears on page 11 of the Appendix to the appellant's brief. The minor errors are as follows:

- Claims 20-39 should be excluded from being reviewed on Appeal because they are part of the Supplemental Amendment, filed on 08 November 2005, which has been denied entry.

(8) Evidence Relied Upon

3,432,016

K. Vogt

03-1969

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Objection to the Substitute Specification:

Substitute Specification filed 23 August 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is, for example, the *Curved member(s)* as opposed to the originally disclosed *ball bearing(s)*.

The original disclosure only disclosed ball bearings. The substitute specification replaced the disclosed ball bearings with curved members. By the substitute specification only setting forth curved members, applicant is broadening his disclosure to include other members, which he did not show possession of at filing. Curved members not only define the originally recited ball bearings but also encompass other types of members or bearings such as cylindrical bearings, tapered bearings, sleeve bearings, and roller bearings, as disclosed in US. Patent No. 3,432,016 to K. Vogt.

Clearly, "ball bearings" are a subset of the "curved members". The original specification does not describe the "ball bearings" in such a way that it would encompass other types of bearings, as mentioned above. Accordingly, the Substitute Specification, filed on 23 August 2004, has not been entered because it introduces new matter.

Rejection Under 35 U.S.C. 112, First Paragraph:

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant originally disclosed only “ball bearings” throughout the entirety of original disclosure.

On 23 August 2004, applicant filed an amendment that included a substitute specification, in which applicant replaced the “ball bearing(s)” with “curved member(s)” throughout the entirety of the original specification, and a single new claim 19, in which applicant also introduced the term “curved member”.

The originally disclosed “ball bearing(s)” limits the claimed bearing(s) to having a spherical type shape such as a ball.

The newly introduced material “curved member”, in place of the originally disclosed “ball bearing(s)”, as presented in the substitute specification, has broadened the specification to include other types of bearings such as the tapered bearing, the cylindrical bearing, the sleeve bearing, and the roller bearing, as disclosed in US. Patent No. 3,432,016 to K. Vogt.

Accordingly, claim 19, as set forth above, contains the limitation, “a plurality of curved members”, which is not originally disclosed or described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, which includes other types of bearing, such as the tapered bearing(s), the cylindrical bearing(s), the sleeve bearing(s) and the roller bearing(s), other than the originally disclosed “ball bearing(s)”.

Rejection Under 35 U.S.C. 102(b):

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 3,432,016 to K. Vogt.

Vogt (Figs. 1-3; column 1, line 46 – column 3, line 7) discloses a magnetic roller clutch comprising:

- A hub body (i.e., Fig. 3, being the combination of at least elements 1, 7 and the interior portion of element 8)
- A first sleeve (1) and a second sleeve (i.e., Fig. 3, being the interior portion of element 8);
- Wherein the first sleeve (1) includes an outer surface that includes a plurality of slots (4); said slots are provided with a forward section (Fig. 2, being the slot portion that element 5 is contacting), a tapered section (Fig. 1, being the slot portion that element 5 is contacting), and an outwardly sloping surface extending from the forward section to the tapered section (see Fig. 1 or 2);
- Wherein the second sleeve (i.e., Fig. 3, being the interior portion of element 8) includes a wall that includes a plurality of steps (see Fig. 1 or 2); and
- A plurality of curved members (5); said curved members travel from the forward section along the outwardly sloping surface toward the tapered section, whereat the curved members contact the steps and transfer torque between the first sleeve and the second sleeve (Figs. 1 and 2).

(10) Response to Argument

Argument with respect to the Substitute Specification:

Applicants argue that a change from “ball bearing” to “curved member” merely makes explicit the curved nature of the spherical ball bearings that were originally disclosed; and therefore, does not introduce new matter into the original specification.

Examiner respectfully disagrees for the reason as set forth in paragraph (9) above and further explained as follows:

The curved member is a broader term than ball bearing and not only includes a ball bearing but also encompasses ball bearing, tapered bearing, cylindrical bearing, sleeve bearing, and any curved member. Therefore, the result of a change from “ball bearing” to “curved member” would introduce new matter into the original disclosure.

Argument with respect to the rejection of Claim 19 under 35 U.S.C. 112, First paragraph:

Applicants argue that a change from “ball bearing” to “curved member” merely makes explicit the curved nature of the spherical ball bearings that were originally disclosed; and therefore, does not introduce new matter into the original specification.

Examiner respectfully disagrees because the original specification only utilizes the term “ball bearing” to describe the claimed element that travels from the forward section along the outwardly sloping surface toward the tapered section, contacts the steps and transfers torque between the first sleeve and the second sleeve. The original specification makes no mention of the term “curved member” or its related functions.

The original specification does not sufficiently disclosed or described the claimed limitation “a plurality of curved members”, as recited in claim 19, in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The curved members not only define the originally recited ball bearings but also encompass other types of members or bearings such as cylindrical bearings, tapered bearings, sleeve bearings, and roller bearings, as disclosed in US. Patent No. 3,432,016 to K. Vogt.

Argument with respect to the rejection of Claim 19 under 35 U.S.C. 102(b):

Applicants argue that Vogt reference is not analogous art because Vogt reference relates to a free wheel coupling device for timepiece while the claimed invention relates to a clutch for use with a wheel. Applicants also argue that Vogt simply does not teach a “hub body”.

Examiner respectfully disagrees for the following reasons:

- First, the present claim 19 makes no mention that the claimed invention, as recited in the claim, is for use with a wheel;
- Second, Vogt discloses a wheel (i.e., Fig. 3), which is interpreted to include a combination of elements 1, 5, 7 and 8;
- Third, Vogt discloses a hub body, which is the interior portion of the above interpreted wheel that includes the combination of at least elements 1, 7 and the interior portion of element 8, as explained in paragraph (9) above and shown in Fig. 3 of the Vogt reference. Although the Vogt

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reference (column 1, line 65) only refers element 7 as wheel, the combination of elements 1, 7 and the interior portion of element 8 can reasonably be interpreted as the claimed hub body, as recited in claim 19; and

- Fourth, with respect to the non-analogous art argument, since Vogt reference anticipates every limitation of the instant claim, as set forth in paragraph (9) above, the rejection of claim 19 under 35 U.S.C. 102(b) is deemed proper.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

David D. Le


January 31, 2006

Conferees:

David D. Le 

Rodney Bonck 

Charles Marmor


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SUPERVISORY PATENT EXAMINER
ART UNIT 3681